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| 09/813,033 | 03/20/2001 | Hiroshi Sasaki | 01154/LH | 2754 |

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EXAMINER

TARAE, CATHERINE MICHELLE

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| ART UNIT | PAPER NUMBER |
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3623

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,033

Applicant(s)

SASAKI ET AL.

Examiner

C. Michelle Tarae

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 3, 2006 has been entered. Claims 1 and 14 have been amended. Claims 1-30 are now pending in this application.

Response to Amendment

2. The amendments to claims 1 and 14 are acknowledged.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilz, Sr. et al. (U.S. 6,152,369).

As per claim 1, Wilz, Sr. et al. discloses a marketing research method for at least one of studying and analyzing a printed matter, wherein copies of the printed matter are to be distributed to at least one of specified and unspecified persons, said method comprising:

storing ID information for identifying the printed matter and access information obtained for each access to an information resource for the printed matter as a result of an operation of: i) optically reading with a reading device an optically readable coded image which is on the printed matter and is obtained by encoding a URL to be used for specifying the information resource on the Internet and which further includes said ID information, ii) restoring said URL and said ID information from the read coded image, and iii) accessing said information resource corresponding to the restored URL via an access device which is connected to said reading device, said printed matter containing a visually readable printed image including at least one of characters and a photographic image and the optically readable coded image (col. 1, lines 52-58; col. 2, lines 58-67; col. 6, lines 57-67; ID information for a printed matter is stored in a bar code symbol that has encoded in it the URL for the information resource of the printed matter. When the bar code symbol is read, the Internet (and the encoded URL) is automatically accessed.); and

at least one of studying and analyzing the printed matter, carried out by an issuer of said printed matter as marketing research, by utilizing said ID information and the access information (col. 31, line 41-col. 32, line 6; The printed matter can be studied or analyzed by anyone desiring to view the printed matter via a web browser. Access to

the printed matter via the web browser is tracked by a document tracking and delivery server, thereby allowing for studying or analyzing the access to the printed matter as well as the circulation of the printed matter.).

As per claim 2, Wilz, Sr. et al. discloses the marketing research method according to claim 1, wherein said information resource corresponding to said URL as restored from said coded image is an information resource adapted to allow at least one of studying and analyzing the printed matter (col. 31, line 41-col. 32, line 6; The printed matter can be studied or analyzed by anyone desiring to view the printed matter via a web browser. Access to the printed matter via the web browser is tracked by a document tracking and delivery server.).

As per claim 3, Wilz, Sr. et al. discloses the marketing research method according to claim 2, wherein said URL includes ID information for identifying said printed matter (col. 17, line 60-col. 18, line 14; col. 31, line 41-col. 32, line 6; The printed matter is identified by the URL. Access to the printed matter via the web browser is tracked by a document tracking and delivery server.).

As per claim 4, Wilz, Sr. et al. discloses the marketing research method according to claim 3, wherein said ID information includes at least one of a name of the printed matter, a type of the printed matter, a date of distribution of copies of the printed matter, a distribution area of copies of the printed matter and a purpose of distribution of copies of the printed matter as identifiable information (col. 17, line 60-col. 18, line 14; col. 24, lines 27-44; col. 31, line 41-col. 32, line 6; The type of printed matter is identified by the URL.).

As per claim 5, Wilz, Sr. et al. discloses the marketing research method according to claim 1 wherein said URL includes ID information for identifying said printed matter (col. 17, line 60-col. 18, line 14; col. 24, lines 27-44; col. 31, line 41-col. 32, line 6; The type of printed matter is identified by the URL.).

As per claim 6, Wilz, Sr. et al. discloses the marketing research method according to claim 5, wherein said ID information includes at least one of a name of the printed matter, a type of the printed matter, a date of distribution of copies of the printed matter, a distribution area of copies of the printed matter and a purpose of distribution of copies of the printed matter as identifiable information (col. 17, line 60-col. 18, line 14; col. 24, lines 27-44; col. 31, line 41-col. 32, line 6; The type of printed matter is identified by the URL.).

As per claim 7, Wilz, Sr. et al. discloses the marketing research method according to claim 1, wherein said coded image further contains a browser starting program for starting a browser for said access device (col. 6, line 57-col. 7, line 24; The bar code symbol may be encoded with a URL as well as with instructions for starting a browser program.).

As per claim 8, Wilz, Sr. et al. discloses the marketing research method according to claim 1, wherein said printed matter is one of a newspaper, a magazine, a book, a journal, a pamphlet, a catalog, a leaflet and a ticket (col. 23, lines 47-60; Printed matter may include books, journals, magazines.).

As per claim 9, Wilz, Sr. et al. discloses the marketing research method according to claim 1, wherein if said printed matter carries at least one of a plurality of

articles and advertisements and the at least one of each article and each advertisement shown on the printed matter is provided with a printed coded image, the URL contained in each of the coded images includes ID information for identifying the at least one of the article and the advertisement, whichever appropriate (col. 23, lines 47-60; col. 34, lines 4-8; Multiple URL encoded images may be included on a printed matter. For example, a writer of a book may include lists of URL encoded images identifying the references cited for the book. The URL encoded images may link to advertisements.).

As per claim 10, Wilz, Sr. et al. discloses the marketing research method according to claim 1, wherein said information resource is an information resource belonging to the issuer of the printed matter (col. 23, lines 47-67; col. 24, lines 3-26; The composer of the URL encoded images may be the writer of the book and the information resource may be their product/service website. The composer of the URL encoded images may identify any information resource they desire.).

As per claim 11, Wilz, Sr. et al. discloses the marketing research method according to claim wherein a plurality of printed matters containing a same advertisement is involved and the advertisement of each of the printed matters is accompanied by a coded image specific to the printed matter, said information resource is an information resource belonging to a sponsor of the advertisement (col. 31, lines 47-67; col. 34, lines 4-8; The URL encoded images may link to advertisements. The encoded images include a URL for identifying the information resource on the Internet as well as an ID for identifying the printed matter. A document tracking and delivery system is used to track access to the printed matter.).

As per claim 12, Wilz, Sr. et al. discloses the marketing research method according to claim 1, wherein the access information on the accesses to the information resource includes at least one of a number of accesses, date and time of each of the accesses and data on each person who accessed the information resource (col. 31, lines 30-67; A document tracking and delivery system is used to track access to the printed matter.).

As per claim 13, Wilz, Sr. et al. discloses the marketing research method according to claim 1, wherein said coded image includes information on at least one of a sound, an image and a text in addition to said URL (col. 31, lines 6-29; The coded images may include multi-media, such as audio-visual messages.).

Claims 14-30 recite substantially similar subject matter as claims 1-13 above. Therefore, claims 14-30 are rejected on the same basis as claims 1-13 above.

Response to Arguments

5. Applicant's arguments are moot in view of the new grounds of rejections provided above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Russell et al. (U.S. 6,988,662) discusses URL encoded images for identifying and accessing information resources on the Internet;
- Russell et al. (U.S. 6,568,595) discusses URL encoded images for identifying and accessing information resources on the Internet;
- Gelbman (U.S. 6,753,830) discusses smart electronic labels;
- Ruppert et al. (U.S. 5,640,002) discusses a portable RF ID tag and barcode reader; and
- Knowles et al. (U.S. 5,869, 819) discusses an Internet-based system for tracking URL encoded objects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae (formerly, C. Michelle Colon) whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 3623

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "C. Michelle Tarae". The signature is fluid and cursive, with the first name "C." and last name "Tarae" clearly visible.

C. Michelle Tarae
Patent Examiner
Art Unit 3623

April 17, 2006